

REMARKS

A substitute power of attorney is being filed concurrently herewith.

Claims 10 and 33 have been amended to specify that the catalyst is a Michael addition catalyst in accordance with page 12, line 16 et seq. Amendments have also been made to conform the claims to the description in the specification at page 6, lines 5-8 which indicates that a monofunctional vinyl compound is a compound having only one vinyl group. As a result of these changes, it is respectfully submitted that the objection and rejection under Section 112 can be withdrawn.

The rejection of claims 1-9 under 35 U.S.C. § 102 over Stark is respectfully traversed.

The rejected claims relate to a curable liquid acryloyl group-containing resin and its production. In contrast, Stark is directed to a solid product in the form of a powder or dispersion containing that solid. On this basis alone, the anticipation rejection is untenable. In addition, there is no suggestion that the Stark product is curable.

Stark teaches a free radical copolymerization of vinyl monomer, hydrolyzed silane monomer, epoxide monomer, and, optionally, an unsaturated 1,3-dicarbonyl monomer. Each of these monomers can be selected from a wide variety of compounds and the amounts of each can vary. To make a selection of monomers which, in combination, corresponded to the reactants in the instant claims would be serendipity since there is no guidance in the reference which points the way to make the appropriate selections. There is no disclosure specifically associating a monofunctional vinyl compound, multifunctional

acrylic ester and dicarbonyl compound which has two active hydrogens in the methylene position nor are there any working examples specifically combining these materials.

Even if, somehow, the appropriate selection of reactants was made, it would also be serendipity to realize the specified equivalent ratios by appropriate selection of amounts of monomers from the ranges which may be disclosed broadly enough to "encompass" them. Here also, Stark provides no guidance which would lead a person skilled in the art to the proper ratios.

As the very best, it can be asserted that Stark constitutes a generic disclosure with respect to the rejected claims. But it is well established that any assertion that a generic disclosure *ipso facto* makes an item of prior art anticipatory is not valid since under that theory, any claim to a genus would inherently disclosed all species. *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 9 USPQ2d 1962, 1970 (Fed Cir. 1989). For this reason also, the anticipation rejection is untenable.

It is respectfully pointed out that an obviousness rejection based on Stark would not be viable. Stark is based on free radical polymerization chemistry in which the unsaturation in the monomers is employed as sites of connection between materials to realize a solid. In contrast, the invention is based on Michael addition chemistry in which a donor acidic site (C-H) is added to an excess of unsaturation so as to leave unsaturation capable of subsequent cure in the product. The monofunctional material is used in the invention to limit network growth of the reaction of difunctional donors (CH₂) with multifunctional acceptors (COCH=CH₂) in the Michael addition. This avoids the problems encountered in the prior art Michael addition of difunctional donors to multifunctional

acceptors described in the application. Nothing in Stark suggests this approach or the product which results from it.


It is also respectfully submitted that the rejection of claims 10-33 under 35 U.S.C. § 103 over Stark in view of Moy should be withdrawn.

Stark has been discussed above. Moy has not been cited to eliminate any of the deficiencies in Stark. Instead, Moy has been cited to show catalysts, curing conditions and parameters, and uses of cured products recited in these dependent claims. Moreover, there is no appropriate basis for combining these two references.

In view of the above amendment and remarks, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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